

REMARKS

Applicants filed an Amendment in this application on June 29, 2009. That Amendment was deemed non-responsive by the Office for the reasons set forth in the Office communication dated November 9, 2009. In particular, the communication stated that the June 29 Amendment, which requested that the Examiner cancel the current claims and add new claims, presented claims directed solely to a separate non-elected invention—i.e., a requirement for restriction could be made between the sets of claims.

Applicants initiated a telephone interview with the Examiner to discuss the communication. A summary of that interview appears above. At the conclusion of the interview, the Examiner agreed to withdraw her requirement for restriction. Applicants now submit this Amendment, and request that Applicants reply to the Office communication by filing again the claim amendments presented in the June 29 Amendment.

As requested, Applicants now submit this Amendment, which presents above the claim amendments requested in the June 29 Amendment. Furthermore, because the bulk of the remarks presented in that Amendment remain relevant, for the Examiner's convenience the relevant parts of those remarks are reproduced in the asterisked section that follows.

* * *

Claims 12-17 are newly presented for examination, with claims 12 and 15 being independent. Claims 1, 2, 4, and 9-11 have been canceled without prejudice or disclaimer of the subject matter previously presented in those claims. New claims 12-17 have been added to provide Applicants with a more complete scope of protection. Support

for these amendments may be found throughout the originally-filed disclosure including, for example, at paragraphs [0105]-[0107] of the specification. Thus, no new matter has been added. Applicants respectfully request favorable reconsideration.

Claims 1, 2, 4, and 9-11 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Because these claims have been canceled, the rejection is rendered moot. However, Applicants considered the grounds for the rejection in presenting their new claims. On this point, Applicants note that the method recited in independent claim 12 includes identifying a non-currency-based account via a computer of the provider and generating a secondary transaction number at a remote server of the provider. The method of claim 12 thus is at least tied to the positively-recited computer and the positively-recited remote server. Therefore, the method is patent-eligible process within the meaning of § 101. Applicants further note that independent claim 15 recites a computer-readable program product comprising a computer-readable storage medium. A computer-readable storage medium is properly characterized as a machine or manufacture under § 101. Thus, claim 15 also is patent-eligible.

Claims 1, 2, 4, and 9-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to recitations of “a non-currency-based cash equivalent amount.” Again, cancellation of these claims renders the rejection moot. Applicants note that the allegedly indefinite recitation does not appear in the new claims.

Turning now to the art rejections, claims 1, 2, 9, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,689,100 to *Carrithers et al.* (“*Carrithers*”) in view of Applicants’ specification, the background section of which the

Office Action considers to admit certain teachings as prior art. Claims 4 and 11 were rejected under § 103(a) as unpatentable over *Carrithers* in view of Applicants' specification and in further view Official Notice and U.S. Patent No. 5,537,314 to *Kanter* ("*Kanter*"). Without conceding the propriety of these rejections, Applicants have canceled these claims and added new claims 12-17. Applicants submit that new independent claims 12 and 15, together with the claims depending from them, are patentably distinct from the cited art for at least the following reasons.

The Office Action relies mainly on *Carrithers* to teach a method for facilitating a non-currency-based transaction. However, the Office Action admits that *Carrithers* fails to teach a STN. For a teaching of a STN, the Office Action relies on the background section of Applicants' specification. That section discusses temporary transaction numbers in the general context of secure transactions. However, nothing in that section teaches or suggests several features recited by claim 12, including generating a STN that is associated with a non-currency based account, creating a STN profile including information relating to a cash equivalent amount available to the STN, auto-filling the STN into a transaction request provided to a merchant, and receiving a transaction authorization request that includes the STN. Therefore, Applicants submit that claim 12 is patentable over any combination of the background section of their specification and, as the Office Action admits, *Carrithers*.

The secondary citation to *Kanter* and the statements of Official Notice at page 3 of the Office Action fail to compensate for the deficiencies in the art discussed above. Neither *Kanter* nor the statements even contemplate a STN, much less any of the

particular features recited in claim 12. Thus, claim 12 is patentable over all of the cited art, whether that art is taken alone or in combination. Accordingly, Applicants submit that claim 12 recites allowable subject matter.

Independent claim 15 recites a computer program product comprising a computer-readable storage medium. Tangibly embodied in the storage medium is control logic comprising computer-readable program codes having features similar to those discussed above with respect to claim 12. Thus, the reasoning set forth there is applicable here. Accordingly, Applicants further submit that claim 15 is allowable.

The remaining claims depend directly from either claim 12 or claim 15. Thus, these claims are patentable for at least the same reasons. Moreover, because each dependent claim defines additional aspects of the invention, Applicants respectfully request individual consideration of the patentability of each dependent claim on its own merits.

* * *

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office communication is deemed necessary for this Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 50-3939.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Jonathan Berschadsky/
Jonathan Berschadsky
Attorney for Applicants
Registration No. 46,551

FITZPATRICK, CELLA, HARPER & SCINTO
1290 Avenue of the Americas
New York, New York 10104-3800
Facsimile: (212) 218-2200

FCIS_WS 4372116_1